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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,252	07/23/2003	Glen J. Anderson	P1933US00	9293

24333 7590 11/14/2006

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EXAMINER	
DUNHAM, JASON B	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/625,252	ANDERSON ET AL.	
	Examiner	Art Unit	
	Jason B. Dunham	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The replacement drawings filed September 1, 2006 have been accepted and claims 1,5-7,11-13, and 17 are 18 were amended in applicant's response to the office action dated June 19, 2006.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1- 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth (U.S. Patent No. 6,285,987) in view of Kiely (U.S. Patent Application Publication No. 2002/0077960).

Referring to claim 1. The combination of Roth and Kiely discloses a method for providing one or more real-time marketing opportunities to third parties during a sales transaction between a customer and a seller for purchasing a product, the real-time marketing opportunity being offered by the seller, the method comprising:

- Establishing a communication connection between the seller and the third parties (Roth: abstract);
- Issuing an alert over the established connection to the third parties that the sales transaction is in progress (Kiely: abstract, figure 3, and paragraph 10) and a bidding process is open for soliciting bids on at least one of the one or more real-

time marketing opportunities (Roth: abstract). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Roth to have included issuing an alert to third parties during the sale transaction, as taught by Kiely, in order to provide means for direct marketing access to customers (Kiely: paragraphs 4 and 10).

- Establishing a time duration for the bidding process associated with the at least one real-time marketing opportunity (Roth: column 7, lines 26 – 33);
- Receiving one or more bids from one or more of the third parties for the at least one real-time marketing opportunity (Roth: abstract); and
- Determining a winning bid for each of the one or more real-time marketing opportunities included in the bidding process based on the one or more bids raised (Roth: figure 2b).

Referring to claim 2. The combination of Roth and Kiely further discloses a method comprising the steps:

- Issuing an end of bidding alert to the one or more third parties that a winning bid has been received (Roth: column 13, lines 16 – 24);
- Completing the transaction between the seller and the customer for the product including the at least one marketing opportunity (Roth: column 12, line 28 – 40).

Referring to claim 3. The combination of Roth and Kiely further discloses a method wherein the one or more real-time marketing opportunities include an opportunity to provide an offer to be included in the transaction for the purchase of the product (Kiely: abstract). Roth teaches providing an advertisement but does not

expressly disclose providing a peripheral, a promotion, a download, or an offer. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Roth to have included providing an offer, as taught by Kiely, in order to provide upsell content to customers (Kiely: paragraphs 13 –15).

Referring to claim 4. Claim 4 is rejected under the same rationale set forth in the rejection of claim 3.

Referring to claims 5 –6. The combination of Roth and Kiely further discloses a method, wherein the step of establishing a communication connection includes:

- Offering general information associated with the one or more real-time marketing opportunities on an Internet site (Roth: abstract) or via a telephone conversation (Kiely: paragraph 24) associated with the seller; and
- Allowing the third parties to establish a communication connection with the seller over the Internet site (Roth: abstract).

It would have been obvious to one of ordinary skill at the time of applicant's invention to have modified the method of Roth to have included communicating via telephone with the seller, as taught by Kiely, in order to allow various methods in which advertisements could be submitted (Kiely: paragraph 24).

Referring to claims 7-18. Claims 7 – 18 are rejected under the same rationale set forth in the rejection of claims 1 – 6. The combination of Roth and Kiely discloses apparatus and articles of manufacture comprising the components disclosed in claims 7 –18.

Response to Arguments

Applicant's arguments filed September 1, 2006 have been fully considered but they are not persuasive.

Applicant argues that the combination of Roth and Kiely does not disclose receiving bids from advertisers during a sales transaction and issuing an alert. The examiner notes that Roth discloses receiving bids from advertisers, or third parties, based upon certain criteria and characteristics of a viewer (Roth: abstract). Kiely discloses, "near the end completion of the transaction, transaction details are communicated to a third party upsell server", for providing an offer (Kiely: abstract). Kiely goes on to disclose that an upsell offer could include advertisements in paragraph 41. Clearly, claim 1 is obvious in view of the combination of Roth and Kiely.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Roth and Kiely both provide methods for providing real-time marketing opportunities to third parties.

Furthermore, the examiner disagrees that Kiely does not disclose issuing an alert to multiple third parties as paragraph 10 and figure 3 of Kiely disclose, "means for

transmitting the captured upsell opportunities to at least one selected upsell server during execution of said transaction."

Independent claims 7 and 13 stand rejected under the same rationale set forth above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBD
Patent Examiner
11/7/06

YOGESH C. GARG
PRIMARY EXAMINER
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